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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/617,067 | 07/16/2000 | Daniel T. Papalia | EN11111 | 7220 |
| 7590 | 12/02/2003 | | EXAMINER | |
| Motorola Energy Systems Group Intellectual Property Department 1700 Belle Meade Court Lawrenceville, GA 30043 | | | BORISOV, IGOR N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/617,067 | PAPALIA ET AL. <i>[Handwritten mark]</i> | |
| | Examiner | Art Unit | |
| | Igor Borissov | 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4-8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-8 and 10-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 4-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 2, it is confusing, because it refers to a system while claiming a method step.

Claims 4-8 are rejected as being dependent from claim 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-8, 10-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasek (US 5,237,507) in view of Edelman et al. (US 6,281,601).

Chasek teaches a system and method for developing real-time economic incentives to encourage efficient use of the resources of a regulated electric utility, comprising:

As per claims 1-2, 10 and 20,

- a plurality of power macnines (column 2, lines 3-9; column 3, lines 51-54);

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- a remote means for actuating the power machines comprising a means for monitoring a market price of electricity (column 3, line 29 through column 5, line 58); a means for monitoring a market price of hydrocarbon fuels (column 3, line 29 through column 5, line 58); a means for calculating the difference between the market price of electricity and the market price of hydrocarbon fuels (column 3, line 29 through column 5, line 58).

Chasek does not specifically teach for a means for actuating a power machine.

Edelman et al. teach a system and method for a distributed generation power networking system comprising a turbogenerator which is controlled (turned on and off) by a controller (column 1, line 56 through column 2, line 5), wherein said controller evaluates local data (column 6, lines 30-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chasek to include means for actuating a power machine including a controller for evaluating local data, because it would enhance the performance and accuracy of the system by evaluating the local conditions, thereby make it more attractive to the customers.

As per claim 4, Chasek teaches said system and method wherein the actuation signal comprises a remote override signal causing the power machine to turn on or turn off (column 4, line 13 through column 5, line 58).

As per claim 5, Chasek teaches said system and method, further comprising a means for reading data from a meter (column 3, lines 51-57).

As per claim 6, Edelman et al. teach said system and method, further comprising a means for reading data related to the operational performance of the power machine (column 1, line 56 through column 7, line 64).

As per claim 7, Chasek teaches said system and method, further comprising a means for reading the local energy rate structure (column 3, line 42 through column 4, line 36).

As per claim 8, Chasek teaches said system and method, further comprising a means to calculate the load demand and to print and prepare a billing statement (column 3, line 58 through column 5, line 23).

As per claim 11, Chasek teaches said system and method, further comprising a means for aggregating power to sell on a power market (column 4, line 13-22).

As per claim 12, Chasek teaches said system and method, further comprising a means for generating a billing statement (column 4, line 13-22).

As per claim 13, Chasek teaches said system and method wherein the electricity generation factor is selected from the group consisting of market rate structure, peak shaving information, load shedding information and information relating to the ability to sell power to the grid (column 4, line 13-22).

As per claim 14, Chasek teaches said system and method wherein the system operates in an environment selected from the group consisting of a traditional environment, a transitional environment, and a competitive environment (column 3, line 58 through column 5, line 57).

As per claim 15, Chasek teaches said system and method, further comprising a means to calculate the load demand and to print and prepare a billing statement (column 3, line 58 through column 5, line 23).

As per claim 16, Chasek teaches said system and method, further comprising a means for selling power to the grid (column 4, line 13 through column 5, line 57).

As per claims 17 and 18, Edelman et al. teach said system and method wherein the system participates in load shedding and peak shaving (Abstract; column 1, line 56 through column 7, line 64).

As per claim 19, Chasek teaches said system and method wherein the data is selected from the group consisting of electricity prices, hydrocarbon prices, resource rate structure, power machine efficiency, power machine operating characteristics, futures prices, environmental data, regulatory rules, load demand, and weather (column 3, line 29 through column 5, line 58).

As per claim 22, Edelman et al. teach said system and method, further comprising monitoring the operational condition of the power machine (column 1, line 56 through column 7, line 64).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chasek and Edelman et al. in view of Norris et al. (US 5,510,780).

As per claim 21, Chasek and Edelman et al. teach all the limitations of claim 21, except for licensing of power machines.

Norris et al. teach a system and method for controlling a power generation equipment wherein said equipment is leased (column 1, lines 6-9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chasek and Edelman et al. to include licensing of power machines, because it would increase the capability of the system thereby make it more attractive to the customers.

Response to Arguments

Applicant's arguments filed 09/22/03 have been fully considered but they are not persuasive.

In response to applicant's argument that sited prior art do not teach a local control circuit for evaluating local data prior to actuating the power machine, examiner points out that Edelman teach said system and method comprising a turbogenerator which is controlled by a controller wherein said controller evaluates local data. Specifically, Edelman teaches that said controller provides both local control and sufficient intelligence to form a distributed processing system data (column 4, lines 8-10; column 6, lines 30-60 and discussion above).

Conclusion

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

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Any response to this action should be mailed to:

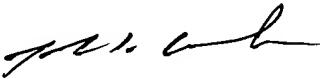
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

DB


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600